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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/687,228 Confirmation No. 9854
Appellant : Steven D. Culhane
Filed : October 16, 2003
TC/A.U. : 3765
Examiner : Alissa L. Hoey

Docket No. : 02-200-US2
Customer No. : 34704

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

APPEAL BRIEF

Sir:

This is an appeal to the Board of Patent Appeals and Interferences from the final rejection of claims 10 - 19, dated April 11, 2005, made by the Primary Examiner in Group Tech Center 3765.

REAL PARTY IN INTEREST

The real party in interest is Cabela's Inc. of Sidney, Nebraska.

RELATED APPEALS AND INTERFERENCES

There are no other prior and pending appeals, interferences or judicial proceedings known to Appellant, Appellant's legal representative, or Assignee which may be related to, directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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STATUS OF CLAIMS

Claims 10 - 19 are pending in the application and are on appeal. Claims 1 - 9 have been cancelled. An appendix containing claims 10 - 19 on appeal is attached hereto.

STATUS OF AMENDMENTS

No amendment was filed subsequent to the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

The claims on appeal relate to a garment (see page 1, lines 7 - 9 of the specification and FIGS. 5 - 7) to be worn by a human being. As set forth in claim 10 and as shown in FIGS. 5 and 6, the garment (60) comprises a front portion (62) and a rear portion (68) and a pair of arms (64, 66) joined to the front and rear portions (see page 7, lines 4 - 5). Each of the arms has an outer elbow portion (86, 88) formed from a stretch fabric material (see page 8, lines 2 - 5) and other portions, such as upper arm portions (87), wrist portions (89), central portion (95) and lower rear portion (97), formed from a non-stretch fabric material (see page 8, lines 5 - 7 and lines 9 - 11). The garment further has underarm portions (90, 92) formed from a stretch fabric material (see page 8, lines 2 - 5).

As pointed out in claim 11, the garment (60) includes the rear portion (68) having at least one portion (94, 96) formed from a stretch fabric material (see page 8, lines 7 - 9 and FIG. 6).

As pointed out in claim 12, the garment has a rear portion which includes first and second side portions (94, 96), each formed from a stretch fabric material, and a central portion (95) (see FIG. 6 and page 8, lines 7 - 11).

As pointed out in claim 13, the central portion (95) is formed from a non-stretch fabric material (see page 8, lines 7 - 11).

As pointed out in claim 14, the garment may have a liner (100) within the garment. (See FIG. 7 and page 8, penultimate line.)

As pointed out in claim 15, the liner (100) can be formed from a breathable waterproof stretch fabric material (102) (see page 8, last line to page 9, line 1).

As pointed out in claim 16, the liner (100) may comprise a stretch fabric material layer (102) and a stretch film material layer (104) (see FIG. 7 and page 8, last line to page 9, line 6).

As pointed out in claim 17, the garment may comprise a hood (82) (see FIG. 6 and page 7, line 19).

As pointed out in claim 18, the hood (82) may be detachable (see page 7, lines 21 - 22).

As pointed out in claim 19, the hood (82) may be collapsible so that it can be stored in a neck portion (84) of the garment (60) (see page 7, lines 20 - 21).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The first ground of rejection to be reviewed on appeal is the rejection of claims 10 - 19 under 35 U.S.C. 112, first paragraph.

The second ground of rejection to be reviewed on appeal is the rejection of claims 10 - 13 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,722,099 to Kratz.

The third ground of rejection to be reviewed on appeal is the rejection of claims 14 - 16 under 35 U.S.C. 103(a) as being unpatentable over Kratz in view of U.S. Patent No. 5,593,754 to Blauer et al.

The fourth ground of rejection to be reviewed on appeal is the rejection of claims 17 - 19 under 35 U.S.C. 103(a) as being unpatentable over Kratz in view of U.S. Patent No. 2,002,955 to Lipson.

ARGUMENT

I. Claims 10 - 19 Comply With The Requirements of 35 U.S.C. 112, first paragraph

It is the Examiner's position that the specification, while being enabling for defining a non-stretch material, does not reasonably provide enablement for defining a non-stretch fabric material. The Examiner contends that the specification does not enable any person skilled in the art to which it pertains, or with which it is mostly nearly connected, to define the invention commensurate in scope with these claims. The Examiner contends that the specification does not define what the non-stretch material is made out of. (See paragraph 9 on page 5 of the final rejection.)

It is Appellant's opinion that the rejection of claims 10 - 19 under 35 U.S.C. 112, first paragraph is improper and should be reversed. The enablement requirement of 35 U.S.C. 112, first paragraph, does not require an applicant to disclose and explain that which is commonly used and well known in the art. See *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). The enablement requirement is set forth in the first paragraph of section 112 of Title 35, U.S.C. which provides in pertinent part that the specification shall describe "the manner and process of

making and using [the invention], in such clear and concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use [the invention]." 35 U.S.C. §112, ¶1 (2000). The case law holds that the enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation. See *In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1400 (Fed. Cir. 1988).

The term "non-stretch fabric material" used in the specification and claims is a term of art that would be well understood by those skilled in the art. It is known in the art that certain woven fiber materials are "non-stretch fabric materials". To demonstrate the usage of the term "non-stretch fabric material", attached hereto, in Appendix D, are excerpts from the Internet showing the common usage of the term to describe certain fabrics. These excerpts have been previously submitted to the Examiner and clearly demonstrate that one of ordinary skill in the art would (1) understand the term at issue; and (2) readily be able to produce the garments of the present invention without any undue experimentation.

The Board's attention is also directed to U.S. Patent No. 4,663,784 that has a palm portion formed from a non-stretch fabric material (see column 1, lines 10 - 11) and to U.S. Patent No. 4,357,714 that is directed to an article that is formed in part from a woven non-stretch fabric (see the Abstract). Copies of these patents have been previously submitted to the Examiner and may be found in Appendix D attached hereto.

Appellant notes that the Examiner in making this rejection does not aver that the garments of the present invention could only be made with a significant amount of experimentation. Thus,

as a matter of law, the Examiner has not made out a case of a lack of enablement. *Id.*

Instead, the Examiner argues that the specification does not provide enablement for "defining" a non-stretch fabric material. It is submitted that the Examiner misunderstands the enablement requirement. The enablement requirement does not require one of ordinary skill in the art to "define" the terms used in the specification. In the instant case, the evidence introduced by Appellant shows that the term at issue requires no definition and would be readily understood by those skilled in the art because it is commonplace. The Examiner provides no evidence to the contrary. The Examiner's arguments are not a substitute for evidence.

The Examiner also avers that the specification does not define what the non-stretch material is made out of. The enablement requirement does not require Appellant to provide examples of non-stretch material in the specification. The sole issue on enablement is whether one of ordinary skill in the art could practice the claimed invention without undue experimentation. *Id.* As noted before, the Examiner has offered no explanation, in light of the evidence produced by Appellant, as to why the claimed invention could not be practiced by one of ordinary skill in the art.

With regard to the Examiner's comments in the paragraph bridging pages 5 and 6 of the final rejection, they are merely the Examiner's opinion or belief. The fact remains that there are a group of materials known by those skilled in the art as "non-stretch fabric materials." This is best demonstrated by the aforementioned U.S. patents.

For these reasons, the rejection under 35 U.S.C. 112, first paragraph, should be reversed.

*II. Independent Claim 10 and
Dependent Claims 11 - 13 Are
Not Anticipated By Kratz*

It is well settled law that in order for a reference to anticipate a claim, all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference. See *In re Robertson*, 159 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999). With regard to the rejection of claims 10 - 13 on anticipation grounds over Kratz, it is submitted that the rejection fails because Kratz lacks an outer elbow portion formed from a non-stretch fabric material. The Kratz patent relied upon by the Examiner relates to a motorcycle garment which has vent portions to maximize cooling. The jacket shown in FIGS. 2 and 3 of Kratz has mesh underarm portions, a mesh inner elbow portion, and mesh portions on the front and back of the jacket. As pointed out in column 5, line 44 et seq. of Kratz, the vents are shaped and positioned to provide maximum air flow utilizing those areas of the jacket which are least likely to come into abrasive contact with the pavement or other surface during an accident. The elbow vents are provided at the cyclist's inner elbows, because these areas are rarely abraded. To provide adequate protection, the back of the jacket is fabricated from an abrasion resistant material. The only mention of a flexible cloth mesh is for the element 116 which is provided to keep out bugs or other debris which might otherwise pass through the scoop 106. While Kratz says that the jacket may be constructed from natural or artificial leather, Kratz is totally silent as to whether either of these materials

is stretchable or non-stretchable. This is because Kratz is indifferent on the subject.

Independent claim 10 is allowable because Kratz does not teach or suggest forming an outer elbow portion from a stretchable fabric material. Claim 10 is further allowable because Kratz never says that other portions of the arms are formed from a non-stretch fabric material and never says that the underarm portions are formed from a stretch fabric material. The Examiner's position on these latter points is without any foundation in Kratz. The Examiner assumes that the stretch fabric is used throughout Kratz, but Kratz does not say that. It is not inherent that the mesh of Kratz has any stretch. The sole purpose of the mesh is to provide ventilation which can be accomplished with a non-stretch mesh material. Similarly, the Examiner's statements about the construction of the artificial leather is without foundation in Kratz. If one looks at the stretch marks on the embodiment of FIG. 8, it appears to Appellant that the non-mesh portions of Kratz' jacket are intended to stretch.

With regard to the Examiner's inherency argument, an element of a claim is not inherent in the disclosure of a prior art reference unless extrinsic evidence clearly shows that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by mere probabilities or possibilities. Further, the mere fact that certain thing may results from a given set of conditions is insufficient to establish inherency. *Id.* at 745-746, 49 USPQ2d at 1950-51. The Examiner has provided no extrinsic evidence to show inherency. Thus, the Examiner's arguments on pages 6 and 7 of the office action does not comply

with the requirements of the existing case law. Even if the Examiner is right about the composition of artificial leather, there is no evidence in support of the statement. There is also nothing which indicates that it is a composition being used by Kratz. Kratz does not disclose the artificial leather described by the Examiner.

Claims 11 - 13 are allowable for the same reasons as claim 10 as well as on their own accord. Kratz does not teach or suggest a rear portion having at least one portion formed from a stretch fabric material. Thus, claim 11 is allowable.

Claim 12 is allowable because there is no disclosure in Kratz of first and second side portions formed from a stretch fabric material. In Kratz, there may be mesh side portions, but there is no discussion of these being made from a stretch fabric material.

Claim 13 is allowable because there is no disclosure in Kratz of forming a central portion from a non-stretch fabric material.

*III. Claims 14 - 16 Are Allowable
Over Kratz In View of Blauer et al.*

Claim 14 is directed to the garment having a liner. Blauer et al. is cited by the Examiner as teaching a breathable fabric liner for outerwear. The Examiner contends that it would have been obvious to provide the outer garment of Kratz with the liner of Blauer et al. since the dual liner would provide the outer garment of Kratz with superior breathability, water fastness, and stretchability keeping the user drier, cooler, and more comfortable. It is submitted that one of ordinary skill in

the art would not be motivated to combine the references in the manner suggested by the Examiner.

The Kratz garment is designed to provide conductive and evaporative cooling by including mesh vents at locations which require little protection (see the Abstract). Kratz specifically says that an object of his invention is to provide ventilated protective clothing where the ventilation is provided in areas which allow maximum cooling with minimum danger (see column 2, lines 44 - 46). Kratz also says it is an object to provide ventilation scoops which provide a desired air flow (see column 2, lines 47 -50). It is submitted that if one were to employ a liner such as Blauer et al.'s in the garment of Kratz, one would interfere with the purpose of the mesh and ventilation scoops in providing ventilation. The liner of Blauer et al. would block such ventilation when applied to the interior of the garment. Thus, one of ordinary skill in the art would not be motivated to combine the references in the manner suggested by the Examiner. For this reason, the obviousness rejection of claim 14 is fatally flawed.

Claim 15 depends from claim 14 and is allowable for the same reasons as claim 14 as well as on its own accord. For the reasons discussed above, one of ordinary skill in the art would not be motivated to employ a breathable waterproof stretch fabric material as a liner in Kratz's garment. It would interfere with the ventilation that Kratz desires.

Claim 16 also depends from claim 14 and is allowable for the same reasons as claim 14 as well as on its own accord. One of ordinary skill in the art would not be motivated to incorporate a liner having a stretch fabric material layer and an adjacent stretch film material layer, such as Blauer et

al.'s, into the Kratz garment because it would interfere with the ventilation which Kratz desires.

*IV. Claims 17 - 19 Are Allowable
over Kratz in view of Lipson*

The Examiner cites Lipson as teaching a detachable, collapsible hood to be worn with an outer garment to protect the wearer's head from the elements. While Lipson teaches such a hood construction, it is submitted that one of ordinary skill in the art would not be motivated to provide Kratz's motorcycle garment with such a hood.

Claims 17 - 19 are each allowable because one of ordinary skill in the art knows that the overwhelming majority of motorcycle operators wear helmets to protect themselves from the elements as well as in accidents. Thus, a hood on the Kratz garment serves no purpose. While one could provide the garment with the hood, there is no real reason to do so. Thus, one of ordinary skill in the art would not be motivated to combine the references in the manner suggested by the Examiner. Further, a raised hood during operation of a motorcycle could be dangerous. It could capture air and create an unsafe environment for the operator. Further, it would likely blow off the operator's head during operation of the motorcycle and thus not serve to protect the operator from the elements.

CONCLUSION

For the foregoing reasons, the Board is hereby requested to reverse the rejection of claims 10 - 19 and remand the application to the Primary Examiner for allowance and issuance.

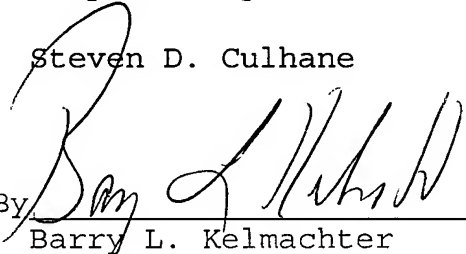
FEES

The Director is hereby authorized to charge Deposit Account No. 02-0184 in the amount of \$500.00 to cover the cost of the Appeal Brief fee. Should the Director determine that an additional fee is due, he is hereby authorized to charge said fee to said Deposit Account.

Respectfully submitted,

Steven D. Culhane

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IN TRIPLICATE

Date: September 9, 2005

I, Nicole Motzer, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on September 9, 2005.





APPENDIX A



CLAIMS 10-19

10. A garment to be worn by a human being comprising:

a front portion and a rear portion;

a pair of arms being joined to said front and rear portions;

each of said arms having an outer elbow portion formed from a stretch fabric material and other portions formed from a non-stretch fabric material; and

underarm portions formed from a stretch fabric material.

11. A garment according to claim 10, wherein the rear portion has at least one portion formed from a stretch fabric material.

12. A garment according to claim 10, wherein the rear portion has first and second side portions and a central portion and wherein each of said first and second side portions is formed from a stretch fabric material.

13. A garment according to claim 12, wherein said central portion is formed from a non-stretch fabric material.

14. A garment according to claim 10, further comprising a liner within the garment.

15. A garment according to claim 14, wherein said liner is formed from a breathable waterproof stretch fabric material.

16. A garment according to claim 14, wherein said liner comprises a stretch fabric material layer and an adjacent stretch film material layer.

17. A garment according to claim 10, further comprising a hood.

18. A garment according to claim 17, wherein said hood is detachable from the garment.

19. A garment according to claim 17, wherein said hood is collapsible.



**APPENDIX B
(NOT APPLICABLE)**

APPENDIX C
(NOT APPLICABLE)



APPENDIX D

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MGS502

Bootliner, Waterproof and
Breathable Knee Length



The Mustang MGS502 Bootliner protects feet from the discomfort and challenges of cold, wet environments. The bootliner is a close fitting, waterproof, moisture vapour permeable liner designed for wear inside operational footwear. The breathable characteristic of the bootliner minimizes perspiration induced wet feet, providing increased comfort and operational efficiency for the wearer. Certain missions may provide circumstances where having wet feet become:

unavoidable, such as traversing deep water. Through continued activity, foot drying occurs as the breathable fabric allows water vapor to pass through to the outside of the liner. Keeping the feet dry improves foot hygiene and greatly reduces incidences of operational foot trauma in cold and wet environments.

The bootliner is specifically designed to provide maximum foot comfort with strategic locations of construction seams to minimize bulk. This results in a smooth and flexible liner which conforms well to the foot, preventing gathering or interference with operational footwear.

The bootliner incorporates both stretch and non-stretch Gore-tex fabric for added wearer comfort. The stretch fabric portion is located around the foot and ankle, ensuring a close fit when worn over a standard woolen work sock. The non-stretch fabric comprises the upper portion and the sole of the bootliner for durability.

The knee length configuration is designed to prevent water ingress while travelling through moderately deep water and assists in the prevention of pant leg soak and freezing.

Leg adjustment is provided with a Velcro fastener around the upper hem to prevent slippage of the liner over the calf. All seams are fully sealed to ensure 100% watertight construction.

Materials

The bootliner is a bi-component design, utilizing a stretchable laminate fabric for shape conformance over the foot and a non-stretch laminate fabric for durability in high wear areas. The stretch component is a 3-layer waterproof and moisture vapor permeable laminate of nylon-spandex knit, microporous film, and nylon tricot knit conforming to MIL 29567. All construction seams are fully sealed using a laminated waterproof tape.

Size

Thirteen sizes are available, men's size 2 through 14. (Note: Full sizes only)

Weight

Approximately 0.45 kg (1lb.) per pair, depending on size.

Color

Olive green, other colors such as disruptive camouflage pattern are possible where quantity permits.

Testing

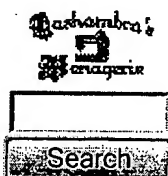
All bootliners are individually tested and proven 100% watertight.

Optional Style

For those operational requirements where the knee length bootliner is considered more coverage than is necessary, the calf length model MGS505 is available. This variant uses the same materials but incorporates a stretch cuff at the calf.

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☒ Ehab's Backing Material Tutorial

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Ehab is a member of *Embroidery Tales mailing list* and he was kind to write up this backing material tutorial for the members so many people would always write in asking these types of questions. Ehab says, "I am writing this information because I r lot of friends asking about backing and topping and here is wha thinking that it might help someone out there."

~~~ Backing Materials ~~~

The use of backing materials and / or toppings will enhance your embroidery. The type of backing needed is determined by the fabric being embroidered. In most cases, backing will be needed to prevent stitches from pulling and distorting the garment. Backing materials give strength to unstable fabrics (and a better appearance on woven fabrics (less puckering and pulling).

Fabrics fit into three general categories

Woven: Non-stretch materials such as satin jackets, towels, denim and canvas

Knits: Stretch materials such as sweaters, sweatshirts, jerseys and t-shirt

Special: Non-woven, non-knit materials such as felt, leather or suede


Backings are used with all knits and stretch fabrics, as well as with most thin sheer fabrics.

~~~ Backing Guidelines ~~~

A loose knit fabric can be embroidered, but without selecting proper stitch density and backing, the garment can be stretched and possibly cut. The operator's concern is to keep fabrics from stretching, puckering, or popping through the stitches during sewing. In general, thinner garments need more stable backing.

Backings range from very lightweight tear-away to heavyweight cut-away, from iron-on to non-adhesive. All serve different purposes.

The most universal backings are:

Fun
Interactive Polls
Past Survey's
Interviews
News Page
Cyber Cards
Game Court
Contact
E-Mail
Newsletter
Keep ~Updated~ Receive Our Newsletter
Good Deeds
A Variety Of Organizations
Web E-Mail
Log In To: Embroidery Mail
Sign Up With: Embroidery Mail
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Counter code has changed. Please update your code.
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Medium-weight tear-away or cut-away types.

Too much backing is just as bad as not enough.

Use one piece of medium-weight backing or two pieces of light-weight backing as a general rule.

Heavier fabrics generally have a tighter weave and will need less backing.

Backing should be cut to completely fit in the hoop, not just as a strip to fit at the center of the hoop. When dealing with an open weave fabric that you don't want to move or gather, using spray adhesive on the backing will help keep it all two together, adding stability.

~~~Softouch~~~

Softouch is a woven backing material made of 100% non-shrinkable polyester. Softouch backing is used with many knits and stretch fabrics. These materials cannot be pulled tightly in a hoop by themselves because they will stretch out of shape. Softouch is used to add stability to the garment while it is being sewn. Without Softouch backing, knits will not hold the stitching and can even be fed down into the hole in the throat plate.

To use Softouch backing, cut a piece slightly larger than the hoop you are using and place it underneath the area of the garment that is going to be monogrammed.

Hoop the garment as usual, using the backing material as though it were part of the garment.

Make sure that the garment is as smooth and snug as possible in the hoop. You may wish to use a dissipating bonding adhesive spray to bond the backing to the garment for better stability.

Cut away the excess backing after embroidering, leaving a small margin around the embroidery. Do not cut the backing between letters and designs. Leaving it in place gives added stability to the embroidery after laundering.

Softouch can also be used with thinner woven fabrics to give better clarity and detail to intricately embroidered designs.

~~~Tear-away~~~

Tear-away is a non-woven material that provides some of the stability of Softouch but can be torn away like paper. It is used with non-stretch fabrics. It is hooped the same manner as Softouch, but it is not strong enough for heavier knits or stretchy materials.

Tear-away gives body to thin materials and is well suited for nylon jackets, blouses, sheets, etc. It will help reduce puckering and pulling on these fabrics.

~~~Cut-away~~~

Cut-away backings include a large assortment of fabrics: heavy non-wovens, woven cotton buckram and woven nylon polyester.

A cut-away backing is a fuller product and provides more support than tear-away backing. Cut-away backings are generally more expensive but are more popular with experienced operators.

~~~Nylon Backing~~~

Nylon backing is used with many knits and stretch fabrics. Use nylon as a substitute for Softouch if the design is not worn against the skin.

Hoopng procedures for nylon are identical to those for Softouch backing.

~~~Backing Paper~~~

Backing paper is used beneath fabrics with a looped or rough texture, e.g., terry or canvas, and with garments that have a rubber lining, e.g., rain slickers or waterproof bags.

This allows the hooped garment to move smoothly while sewing, decreasing chance of dragging.

The backing paper is not put in the hoop with the material, but is placed under the hoop, between the garment and the sewing surface. When the embroidery is finished the paper can be pulled away.

CAUTION!

Backing paper has a tendency to shred during sewing, small pieces of paper get caught in the hook and jam the machine. Be sure to clean away all excess pieces of paper that may be left after embroidering.

~~~Water Soluble Topping~~~

Water soluble plastic foil is used as a topping to prevent stitching from getting into knit fabrics, keep terry cloth loops down, and to allow greater clarification of intricate details.

Using Water Soluble Topping

1. Place water soluble topping on top of the fabric and hoop both.
2. After the embroidery process is complete, tear away the water soluble topping outside the design.
3. Spritz very lightly with warm water to dissolve water soluble topping.
4. A soft bristle brush may be used to help remove remaining water soluble topping particles. Pass the brush lightly over the top of embroidery to raise the fabric.

Embroidery should not be left damp or wet longer than a few minutes.
